REMARKS

Please note that a supplemental Information Disclosure Statement was filed on May 29, 2007. The examiner is respectfully requested to return an initialed copy of the form PTO-1449 attached thereto at the next opportunity.

Claims 1-13, 15, 16, 18-25, 27-33, 35-41, and 43-45 are pending. Claims 14, 17, 26, 34, and 42 are deleted. The applicant respectfully requests reconsideration and allowance of this application in view of the above amendments and the following remarks.

Claim 38 is amended to correct a typographical error so that the word "amd" reads "and."

Claims 1-13, 15, 16, 18-25, 27-33, 35-41, and 43-45 were rejected under 35 USC 102(e) as being anticipated by U.S. Patent Pub. No. 2002/0011636, Grainger ("Grainger"). Insofar as the rejection may be applied to the claims as amended, the applicant respectfully traverses the rejection for reasons including the following, which are provided by way of example.

The application recognizes that personnel may wish to "label attributes of various intellectual properties and related documents of a company, its partners, and/or competitors, and/or to manage the attributes, to utilize attributes in filtering intellectual property documents." (Page 4, lines 9-12.) Independent claim 1 recites in combination, for example, that "an attribute type can have a plurality of attributes, the attributes and the attribute types are ordered in a tree-structure hierarchy and an attribute type can have parent and child attribute types, a document can be assigned a plurality of attribute types at a same and/or different level in the hierarchy, a document can be assigned a plurality of attributes for one attribute type,..." Independent claim 1 also recites "providing a group of a plurality of documents including at least one document; (B) selecting a plurality of attributes to be associated with the at least one document, wherein the selected attributes can be any of the plurality of attributes; and (C) for each of the selected

13

attributes, automatically tagging ... the documents in the group ... with each selected attribute and with all attributes of all ancestors but not descendants or siblings in the hierarchy of each selected attribute; and storing ... respective references in association with each selected attribute and the ancestor attributes, ..." (See also independent claims 22, 30 and 38.) Thereby, the method and system can provide that "all of the attributes that otherwise would have been selected in a step-by-step manner may be assigned simultaneously and automatically by tagging the intellectual property document or file with not only the selected attribute(s), but all of the other attributes that are at a level higher than the selected attributes." (E.g., specification page 58, lines 1-5.)

On the other hand, without conceding that Grainger discloses any feature of the present invention, Grainger is directed to managing documents related to a patent application. A Case Data Unit can store bibliographic information (case meta data) associated with a patent case, and electronic documents related to the patent case. Each document in a Case Data Unit includes document meta data to identify the document; the document and the document meta data are referred to as a Document Entity. (Paragraphs [0057], [0058], [0059].) When a Document Entity is created within the context of a Case Data Unit, the Document Entity can acquire some of its attributes from that Case Data Unit. (Paragraph [0067].)

The office action asserts that Grainger anticipates the invention as claimed. To the contrary, Grainger fails to set forth each and every element found in the claims. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be

14

Serial No. 10/725,531   Attorney Docket No. 113708.130US1

arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Examples of elements which Grainger fails to teach or suggest are discussed below.

Grainger fails to teach or suggest, for example, "the attributes and the attribute types are

ordered in a tree-structure hierarchy." The office action cites Grainger paragraph [0056] as

teaching attributes ordered in a tree-structure hierarchy. Grainger's generic data structure is not,

and does not include, a "attributes and attribute types ordered in a tree-structure hierarchy." (See

claims 1, 22, 30 and 38.) It is unclear how the examiner considers Grainger's generic data

structure necessarily to be a "tree-structure hierarchy," or how the examiner considers that

Grainger's generic data structure must be a structure of attributes and attribute types. The cited

portion of Grainger refers to the Case Data Unit, a "data structure capable of storing data and

documents". However, the claims recite that "the attributes and the attribute types are ordered in

a tree-structure hierarchy." Claims can only be given their "broadest reasonable interpretation."

In re Marosi, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) ("Claims are not to be read in a

vacuum, and limitations therein are to be interpreted in light of the specification in giving them

their 'broadest reasonable interpretation'." 710 F.2d at 802, 218 USPQ at 292 (quoting *In re

Okuzawa*, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976)) (emphasis in original). It is

completely unreasonable for the examiner to ignore the "tree-structure hierarchy" limitation or to

ignore that it is the attributes and attribute types which are so ordered. Consequently, Grainger

fails to teach or suggest the recited tree-structure hierarchy in which the attributes and attribute

types are ordered.

Apparently the examiner considers that a mere "data structure capable of storing data and

documents" teaches a tree-structure hierarchy. To the contrary, a general "data structure" fails to

show a tree-structure hierarchy "in as complete detail as contained in the ... claim." *In re Bond*,

910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). A detailed review of Grainger shows that

15

there is no mention in Grainger of a tree-structure, in connection with attributes or otherwise. Accordingly, there is no *prima facie* case of anticipation.

Furthermore, Grainger fails to teach or suggest "for each of the selected attributes, automatically tagging, in the first data storage, the documents ... with each selected attribute and with all attributes of all ancestors but not descendants or siblings in the hierarchy of each selected attribute; ..." The office action contends that Grainger teaches that a document can be assigned a plurality of attribute types at a same and/or different level in the hierarchy, citing Grainger paragraph [0109] as being particularly relevant. According to Grainger paragraph [0109], a user "can navigate through documents, cases and case families using multiple groupings. Example groupings include: company, division (multiple levels), business units, products, projects, classification and technology." Grainger further explains that users and Case Data Units can be assigned to groups, and a user can have access to Case Data Units in the group and subsets of the group. (Paragraph [00061].) Hence, according to Grainger, assigning a Case Data Unit to a group (e.g., a division) does not cause the Case Data Unit (let alone a document) to undergo "automatically tagging ... the documents in the group ... with each selected attribute and with all attributes of all ancestors but not descendants or siblings in the hierarchy of each selected attribute." To the contrary, Grainger does not teach tagging with attributes of all ancestors in the hierarchy.

More particularly, Grainger teaches away from tagging with all attributes of the ancestors in the hierarchy. Specifically, Grainger teaches that "users not assigned to the group will not have access to Case Data Units in that group" (paragraph [0061]). Hence, Grainger specifically teaches away from automatically tagging a Case Data Unit with additional groups (i.e. ancestors in the hierarchy), because to do otherwise would allow users access to Case Data Units in other groups. Therefore, not only does Grainger not teach automatically tagging with attributes of all

16

ancestors in the hierarchy of each selected attribute, to modify Grainger to do so would destroy a purpose of Grainger.

The office action contends that Grainger, paragraph [0016], lines 1-5, teaches "automatically tagging ... the documents ... with each selected attribute and with all attributes of all ancestors but not descendants or siblings in the hierarchy of each selected attribute ...". The portion of Grainger cited as most relevant simply states that "each of the plurality of electronic documents has one or more attributes associated therewith..." To the contrary, Grainger fails to teach or suggest anything about a tree-structure hierarchy of attributes, or that attributes have ancestors, "in as complete detail as contained in the ... claim." *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

The examiner contends that Grainger's Case Data Unit is analogous to a tree-structure hierarchy – which applicant disputes. According to Grainger, "when a Document Entity is created within the context of a Case Data Unit, the Document Entity acquires some of its attributes from that Case Data Unit. For example, an amendment created for a particular patent application will automatically acquire some attributes of that patent application such as technology developer reference number, practitioner reference number, etc." ([Paragraph [0067]). According to Grainger, the Document Entity acquires only some, but not all, of the attributes of the Case Data Unit. Thus, Grainger fails to teach or suggest that the documents are automatically tagged with all attributes of all ancestors in the hierarchy of each selected attribute.

To further distinguish Grainger's flat structure of a Case Data Unit containing a Document Entity from a tree-structure hierarchy, the independent claims now recite that "an attribute type can have parent and child attribute types." Due to Grainger's flat structure, it is not possible for an attribute to have both parent and child attributes.

17

Grainger fails to teach or suggest, for example, these elements recited in independent claims 1, 22, 30 and 38. Indeed, if Grainger is interpreted as the examiner contends, at least one express purpose of Grainger is destroyed. It is respectfully submitted therefore that claims 1, 22, 30 and 38 are patentable over Grainger, alone or in combination with the other references of record.

For at least these reasons, the combination of features recited in independent claims 1, 22, 30 and 38, when interpreted as a whole, is submitted to patentably distinguish over the references. In addition, Grainger clearly fails to show other recited elements as well.

With respect to the rejected dependent claims, applicant respectfully submits that these claims are allowable not only by virtue of their dependency from independent claims 1, 22, 30 and 38, but also because of additional features they recite in combination. In addition, it is noted that the office action has typographical errors in its numbering of dependent claims 4 and 5.

Furthermore, it is noted that the office action fails to attempt to make a complete *prima facie* of anticipation for various dependent claims. These are outlined below.

Claim 15 recites that "the attributes are selected from a plurality of attribute types representative of at least one of: a product and a service." The office action argues that Grainger discloses a plurality of attribute types, and cites Grainger paragraph [0016]. The office action is devoid of any indication where Grainger teaches attribute types representative of <u>product or service</u>. In any event, Grainger fails to teach or suggest attribute types representative of product or service. Accordingly, claim 15 is allowable over the reference.

Claims 25, 33, and 41 also include the same recitations as claim 15. The rejections of claims 25, 33 and 41 in Office Action merely refer back to the rejection of claim 15. Accordingly, claims 25, 33 and 41 are allowable over the reference.

18

Claim 18 additionally recites "the step of exporting the tree structure hierarchy including the attributes and the attribute types." The office action argues that Grainger paragraph [0016] discloses a plurality of attribute types, and that Grainger paragraph [0134] teaches attribute types associated with document entities. These citations are peculiarly irrelevant to the entirety of claim 18. The office action is devoid of any attempt to argue that Grainger teaches exporting any data structure, let alone a tree structure hierarchy. In any event, Grainger does not teach or suggest exporting the tree structure hierarchy including attributes and attribute types. Therefore, claim 18 is allowable over the reference.

Claim 20 depends from dependent claim 19. Claim 19 recites "further comprising utilizing the attributes as criteria for at least one of searching, retrieving, reporting and viewing the at least one document." Claim 20 then recites that "the attributes can be utilized in combination with: (i) at least one of the attribute types, (ii) at least one sub-type of the at least one attribute type, (iii) a content of at least one field in the at least one document; (iv) a type of at least one field in the at least one document; and (vi) information derived from the at least one field in the at least one document." The examiner appears to have mistaken the word "and" in claim 20 for the word "or", and has considered only element (i) recited in claim 20: the office action merely states with regard to claim 20 that "Grainger discloses 'an attribute type' (type attribute associated with document Entities, [0134])." There is no attempt to show where Grainger teaches elements (ii) – (vi). Because the office action fails to even attempt to show where Grainger teaches five of the elements recited in claim 20, the rejection of claim 20 must be withdrawn.

Claims 28, 36 and 44 include the same recitations as claim 20. The rejections of claims 28, 36 and 44 in Office Action merely refer back to the rejection of claim 20. Accordingly, claims 28, 36 and 44 are allowable over the reference.

19

Serial No. 10/725,531   Attorney Docket No. 113708.130US1

Support for the amended claims is located in the application as filed, for example, page

60 and FIG. 24, and thus the amendments do not introduce any new matter.

The applicant respectfully submits that, as described above, the cited prior art does not

show or suggest the combination of features recited in the claims. The applicant does not

concede that the cited prior art shows any of the elements recited in the claims. However, the

applicant has provided specific examples of elements in the claims that are clearly not present in

the cited prior art.

The applicant strongly emphasizes that one reviewing the prosecution history should not

interpret any of the examples applicant has described herein in connection with distinguishing

over the prior art as limiting to those specific features in isolation. Rather, for the sake of

simplicity, the applicant has provided examples of why the claims described above are

distinguishable over the cited prior art.

In view of the foregoing, the applicant submits that this application is in condition for

allowance. A timely notice to that effect is respectfully requested. If questions relating to

patentability remain, the examiner is invited to contact the undersigned by telephone.

If there are any problems with the payment of fees, please charge any underpayments and

credit any overpayments to Deposit Account No. 50-1147.

Respectfully submitted,

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20